REMARKS

Entry of the foregoing amendments is respectfully requested.

Summary of Amendments

By the foregoing amendments claim 21 is amended. All claims of record (claims 21-33, 35, 37, 38, 40, 42-47 and 53-57) remain pending, with claims 21, 37 and 47 being independent claims.

Summary of Office Action

Claims 37, 38 and 40 are allowed.

Claims 21-33, 35, 42-46, 53, 54 and 57 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Claims 21-33, 35 and 42-47 and 53-57 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 97/42922 (hereafter "WO'922") in view of U.S. Patent No. 5,681,301 to Yang et al. (hereafter "YANG").

Response to Office Action

Reconsideration and withdrawal of the rejections of record are respectfully requested in view of the foregoing amendments and the following remarks.

Response to Rejection of Claims under 35 U.S.C. § 112, First Paragraph

Claims 21-33, 35, 42-46, 53, 54 and 57 are rejected under 35 U.S.C. § 112, first paragraph, as

allegedly failing to comply with the written description requirement. The rejection asserts that the negative limitation "non-adhesive" in claim 21 is "new matter" under the rule set forth in *Ex parte Grasselli et al.* to the effect that limitations such as "free of" a certain ingredient or element allegedly are new matter in the absence of an express disclosure reciting the same. The rejection also asserts that the passage of the present specification which states:

> "Furthermore, the nonwoven that has been treated to make it self-adhesive can also be employed with outstanding effect as an adhesive tape."

does not provide "adequate support for the presence of adhesive materials such as those that are adhesive, but not self-adhesive, from being present".

Applicants respectfully traverse this rejection. With respect to the support of the recitation of the absence of an element in a claim the Examiner is respectfully referred to the MPEP, for example, the following passages thereof (underlining added):

2163.04 Burden on the Examiner with Regard to the Written Description Requirement

The inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

2163.07(a) Inherent Function, Theory, or Advantage

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973). "To establish inherency, the extrinsic evidence 'must make clear that

the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

2173.05(i) Negative Limitations

...

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

Applicants submit that the fact that the present specification points out that the nonwoven has to be treated in order to make it self-adhesive clearly and unambiguously implies that the nonwoven itself is not self-adhesive. Also, it would apparently make no sense at all to treat the nonwoven to make it self-adhesive if an adhesive is already present thereon.

At any rate, present claim 21 has been amended to recite therein that the nonwoven backing material is non-self-adhesive, a statement that may even be considered to be redundant in view of the fact that claim 21 also states that at least one side of the nonwoven backing material carries a coating of a self-adhesive composition (which would make no sense if the nonwoven were self-adhesive by itself).

For at least all of the foregoing reasons the rejection of claim 21 and the claims dependent

therefrom under 35 U.S.C. § 112, first paragraph, is unwarranted and should be withdrawn, which action is respectfully requested.

Response to Rejection of Claims under 35 U.S.C. § 103(a)

Claims 21-33, 35 and 42-47 and 53-57 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO'922 in view of YANG. In this regard, the Office Action refers to the reasons set forth in the previous Office Actions and additionally alleges that WO'922 "clearly teaches the presence of polyethylene fibers as suitable for use in its nonwoven". The Examiner takes the position that this fact, coupled with the many advantageous properties of materials formed from metallocene catalyzed polyethylene allegedly taught be YANG provides "more than ample motivation for using such materials".

Applicants respectfully traverse this rejection for all of the reasons set forth in the Amendments filed April 27 and December 12, 2006. In this regard, it is again pointed out that with respect to the thermoplastic elastomer that can be used for the fibers of WO'922, this document states at page 4, lines 25-35 that the choice of thermoplastic elastomer for the woven fabric or nonwoven fabric described therein is not critical. This clearly fails to provide a motivation for one of ordinary skill in the art to use (presumably relatively expensive) specialty polymers such as metallocene-catalyzed polyethylene for making the fabric of WO'922.

The fact that WO'922 does not even particularly recommend regular polyethylene as fiber material and in Example 1 thereof uses a hydrogenated styrene-isoprene-styrene block copolymer, i.e., a polymer which has hardly anything in common with polyethylene, is an additional reason why one of ordinary skill in the art would not have any motivation to look for polyethylene polymers, let

alone polyethylene specialty polymers, for use in the nonwoven or woven fabric of WO'922.

Further, the Examiner's assertion that YANG teaches "many advantageous properties of materials formed from metallocene catalyzed polyethylene" apparently does not take into account that the "materials" of YANG are not materials made from fibers but are exclusively film materials. As pointed out before, YANG is completely silent as to fibrous materials.

In this regard, Applicants note that the Examiner has not explained, let alone provided any evidence, why (that) one of ordinary skill in the art would have to assume that (nonwoven) fiber materials made of the metallocene catalyzed polyethylene of YANG would show properties which are at least very similar to the properties that are described by YANG for film materials. In other words, the Examiner has not established that with respect to the properties addressed by YANG one of ordinary skill in the art would assume that it does not matter whether the material is a film or a nonwoven, i.e., that if a film shows a specific (advantageous) property it can reasonably be expected that a corresponding nonwoven will also show this property.

Applicants submit that for at least all of the reasons set forth above and the additional reasons set forth in the Amendments filed April 27 and December 12, 2006, WO'922 in view of YANG does not render obvious the subject matter of any of the present claims. Accordingly, the rejection under 35 U.S.C. § 103(a) is unwarranted, wherefore withdrawal thereof is respectfully requested.

CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are in condition for allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned

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at the telephone number below.

Respectfully submitted,
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